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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,443	11/21/2003	Chris Bradford	EL-8218	8058

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EXAMINER

GREEN, ANTHONY J

ART UNIT PAPER NUMBER

1755

DATE MAILED: 04/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/717,443

Applicant(s)

BRADFORD ET AL.

Examiner

Anthony J. Green

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3,5-17 and 22-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,3,5,6,8,9,22 and 23 is/are allowed.
- 6) ☒ Claim(s) 7,10-17,24-27,29,30,32 and 33 is/are rejected.
- 7) ☒ Claim(s) 10-12, 14-17 and 28-32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment submitted on 22 February 2005. Claims 1, 4, and 18-21 have been canceled and new claim 33 added. Currently claims 2-3, 5-17 and 22-33 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 13-17, 24-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Applicants deletion of the water component in claim 13 appears to be new matter as it is not seen as to where the specification recites the treatment of hectorite with the one or more phosphonate additives. That is, the specification seems to suggest that the a mixture of hectorite and water is treated with the one or more phosphonate additive. Accordingly it appears that water is a necessary component in the treatment process absent evidence showing otherwise.

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4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 7, 10-17, 24-27, 29-30, and 32-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 7 the use of the phrase "can be" in the description for the R¹, R², and R⁴ and R⁵ substituents is not a positive claim recitation. The phrase "select4ed from the group comprising" is improper Markush terminology as "comprising" should be -- consisting of --.

In claim 10 the phrases "the hectorite clay comprises about 0.1 to 10 wt%" and "the one or more phosphonate additives comprise about 0.5 to 6 wt%" are confusing as it is unclear as to what they comprise. That is, the claim reads "the hectorite clay comprises about 0.1 to 10 wt%" however it is not clear as to what is comprises. It appears that the paint formulation comprises about 0.1 to 10 wt% hectorite clay however this is not what the claim states. Clarification is requested.

In claim 13 the phrase "the treated mixture" found in part b) of the claim, lacks proper antecedent basis.

Claim 14 is confusing as it teaches the use of "water" however no water appears in claim 13 (the claim from which 14 depends).

In claim 15 the use of the phrase "the hectorite clay" is inconsistent with the terminology used in claim 14 as applicant does not refer to "hectorite clay" but rather simply "hectorite". Applicant needs to use consistent terminology so that it is clear as to

what is being claimed. The phrase "are added as a mixture" is not completely understood. They are added as a mixture to what?

Claim 25 is confusing as it makes reference to water however no water is recited in claim 13 (the claim from which this claim depends). Also claim 13 does not positively recite "clay".

Claim 29 is confusing as it is unclear as to what is meant by the phrase "were added as a pregel". Where, how and to what were they added? Also the use of the phrase "were added" is confusing as this phrase appears to be in the past tense.

Claim 30 is confusing as it is unclear as to what is meant by the phrase "were added as a post correction additive". Where, how and to what were they added? Also the use of the phrase "were added" is confusing as this phrase appears to be in the past tense.

The preamble of claim 32 is inconsistent with that of claim 28 as claim 28 is not directed to a "sprayable metallic formulation". The use of "were added" is confusing as this phrase appears to be in the past tense.

Claim 33 contains improper Markush terminology.

Claim Objections

6. Claims 10-12, 14-17 and 28-32 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form.

The range for the hectorite clay found in claim 10 is outside the range of claim 23 therefore it does not further limit claim 23.

Claim 14 appears to be broader than claim 13 as claim 13 does not recite that water is present.

Claim 28 does not appear to further limit as it is unclear as to how the formulation being the form of a "sprayable metallic paint" (which is not a positive recitation) further limits the paint formulation itself.

Allowable Subject Matter

7. Claims 2-3, 5, 6, 8-9, and 22-23 are allowable over the art of record. The closest prior art is Coutelle et al (US Patent No. 5,582,638) however this reference teaches the use of synthetic hectorite and applicants have discovered the unexpected advantage of natural hectorite versus synthetic hectorite in metal-containing automotive paints.

Applicants have disclosed the advantages of natural hectorite over synthetic hectorite in the specification. See especially the comparative experiments starting at page 16, Example 2 which demonstrate advantages related in general to metal control, solids level, and stability in metal containing automotive paints. Therefore the use of natural hectorite in combination with phosphonate additives is not obvious from the prior art.

8. Claims 7, 10-12, and 28-33 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. 112, 2nd paragraph and/or if rewritten or amended to overcome any claim objections, if applicable, set forth in this Office action.

Conclusion


9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Anthony J. Green
Primary Examiner
Art Unit 1755

ajg
April 07, 2005